

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

The specification has been amended to update the status of the application set forth on page 2. Claims 15 and 41 have been amended to insert the definition of  $\pi$ . Claims 1-51 remain pending in this application.

Claims 15, 16, 41 and 42 have been rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth in paragraph (1) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The legal standard for determining compliance with the second paragraph of 35 U.S.C. § 112 is whether the claims reasonably apprise those of ordinary skill in the art of their scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

The feature described in claims 15, 16, 41 and 42 is discussed in the specification on page 6, lines 9-15 and page 7, lines 15-23. It is clear from the aforementioned portion of the disclosure that these claims encompass compositions derived from at least two isocyanate monomers wherein at least one of the isocyanates in the mixture of isocyanates

contains polymethylene chains and wherein at least one third of all masked isocyanates contain a polymethylene chain. Applicants respectfully submit that the language of these claims reasonably apprises those of ordinary skill in the art of the scope of the claims.

For at least the above reasons, the § 112, second paragraph rejection of claims 15, 16, 41 and 42 should be withdrawn. Such action is earnestly requested.

Claims 1-24 and 51 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons given in paragraph (2) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The liberation of masking agent is discussed on page 6, lines 1-8 of the specification. The Octanol Test referred to on page 6, line 7 is described on page 29. The degree of liberation refers to the fact that at 120°C., no more than 5% of isocyanate functions remain masked, i.e., at least 95% of the isocyanate functions have been deblocked. The scope of the language relating to degree of liberation with respect to the masking agent would readily be apparent to those of ordinary skill in this art.

Applicants note further that the terminology "degree of liberation (with respect to the masking agent) at 120°C. of not more than 5%" occurs in the claims of U.S. Patent 6,291,624 (incorporated by reference on page 2). Thus, the Patent and Trademark Office has already concluded that the above quoted language is acceptable. For at least the above reasons, the § 112, second paragraph rejection of claims 1-24 and 51 should be withdrawn.

Claims 1-50 stand rejected under 35 U.S.C. § 112, first paragraph, for reasons given in paragraph (3) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The first paragraph of 35 U.S.C. § 112 requires that the specification enable one skilled in the art to make and use the invention without undue experimentation. See In re Borkowski, 164 USPQ 642 (CCPA 1970). A detailed description or working example of every possible embodiment falling within a particular claim is not a requirement of the first paragraph of 35 U.S.C. § 112. In this regard, it is not the function of claims to specifically exclude possible inoperative embodiments. See, *e.g.*, In re Dinh-Nguyen, 181 USPQ 46 (CCPA 1974); Ex parte Janin, 209 USPQ 761 (POBA 1979); and Ex parte Jackson, 217 USPQ 804 (POBA 1982). The breadth of the claims is irrelevant so long as they set forth an invention which is described in the specification such that one skilled in the art can make and use the invention. The Examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually.

With the above principles in mind, applicants respectfully submit that the scope of enablement in the present application is commensurate in scope with the claims when considered as a whole. Those skilled in the art would readily be able to practice the claimed invention given the information in the disclosure coupled with the level of knowledge and skill in the art. The scope of enablement only needs to bear a "reasonable correlation" to the scope of the claims. As the Court stated in *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976). "[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for

"preferred" materials in a process such as the one herein involved would not service the constitutional purpose of promoting progress in the useful arts."

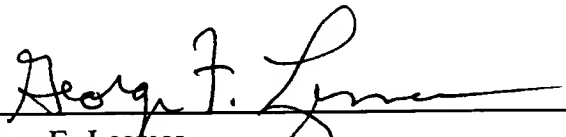
The generic feature of the present invention is set forth on page 4, lines 2-8 of the disclosure and in claim 1. A preferred feature of the invention is set forth on page 4, lines 9-26 and in claim 25. Those of ordinary skill in this art would not have to resort to undue experimentation in order to practice the invention. Regarding the Examiner's comments on the cited Ardaud '624 patent, Applicants note that there are significant differences between the present claims and those of the '624 patent. The respective claims are drawn to patentably distinct inventions.

For at least the aforementioned reasons, the § 112, first paragraph rejection should be withdrawn. Such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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**Attachment to Amendment dated April 15, 2003**

**Marked-up Copy**

Page 2, Paragraph Beginning at Line 17

The coating powders may be in several finishes (surface aspect, color, sheen, etc.). For example, copending application Serial No. 09/240,598, filed February 1, 1999, now U.S. Patent 6,291,624, the entire contents of which are herein incorporated by reference, describes compositions for obtaining matt or satin coatings. Such coatings are defined therein as having a coefficient of reflection which is at most equal to about 50% at a 60° angle of incidence.

**Attachment to Amendment dated April 15, 2003**

**Marked-up Claims 15 and 41**

15. (Amended) The composition according to claim 1, further comprising one or more additional isocyanates at least partially masked by the one or more masking agents, wherein at least one of the isocyanates contains polymethylene chains  $(CH_2)_\pi$  where  $\pi$  is an integer of 2 to 10 and said chains represent one third or more of the masked isocyanates.

41. (Twice Amended) The composition according to claim 25, further comprising one or more additional isocyanates at least partially masked by the one or more masking agents, wherein at least one of the isocyanates contains polymethylene chains  $(CH_2)_\pi$  where  $\pi$  is an integer of 2 to 10 and said chains represent one third or more of the masked isocyanates.